



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,101	08/17/2000	Bengt A. Carlson	835-007.3	6166

4955 7590 04/04/2006

WARE FRESSOLA VAN DER SLUYS &
ADOLPHSON, LLP
BRADFORD GREEN BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
----------	--------------

3754

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,101

Applicant(s)

CARLSON ET AL.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 28-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-22 and 28-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 17, 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is noted that corrected drawings were not submitted with the response of October 19, 2005 or January 9, 2006 nor were the features that were not shown cancelled from the claims. However, to further prosecution, the examiner will hold the objection in abeyance for purposes of entering the amendment of January 9, 2006 only.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the features canceled from the claims (no new matter should be entered into the drawings):
 - i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42);
 - ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42);
 - iii) the insert member attached to the valve seat (claims 20, 31, and 38);
 - iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
 - v) the insert members made of plastic (claim 15);
 - vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14);
 - vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11);
 - viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40); and
 - ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 10-17, 19, 20, 22, and 28-45 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

- i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42);
- ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42);
- iii) the insert member attached to the valve seat (claims 20, 31, and 38);
- iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
- v) the insert members made of plastic (claim 15);

vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14);

vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11);

viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40); and

ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45).

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10-17, 19, 20, 22, and 28-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42);

ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42);

iii) the insert member attached to the valve seat (claims 20, 31, and 38);

iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);

v) the insert members made of plastic (claim 15);

vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14);

vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11);

viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40); and

ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45).

6. Claims 18 and 21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During prosecution of US Patent Application Number 09/084,698 (US Patent Number 6,039,304, the basis of the present reissue application), the following subject matter relating to the exact manner in which the insert disk is retained (attached) was introduced into independent claims 1, 15, and 22 in order to avoid art rejections and is subject matter that is surrendered (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance):

“wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”

Applicants' reissue claims 18 and 21 are rejected on the ground of improper recapture of subject matter surrendered during prosecution to avoid art rejections. Reissue claims 18 and 21 have broadened the limitations regarding the exact manner in which the disk insert is attached across the fluid passage by reciting that the inserts are merely “attachable across said fluid passage”. Since this broadened aspect of the claims relates to the surrendered subject matter, in that the exact manner of attachment was the same subject matter that was surrendered during prosecution of the original application (i.e. introduced because it was necessary to overcome the art rejections), and since recapture was not avoided (in the reissue claims) by addition of limitations relating to the specific aspect that was narrowed during prosecution (i.e. the exact manner of attachment), the broadening of the claims represents improper recapture.

Response to Arguments

7. Applicant's arguments filed January 9, 2006 have been fully considered but they are not persuasive.

Re limitation i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42), applicants argue that the flange (ref no. 8 in Fig. 8 of '304) is equivalent in its function to the connector of '890. The examiner disagrees, the flange of '304 does not connect to anything; therefore, it is not a connector. In fact, the limitations added to the independent claims of '304 are directed to the retaining ring (9), which is a necessary component because the insert member has no connectors. In contrast, the connector (48 of '890) connects to either the valving member or the valve seat.

Re limitations ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42) and iii) the insert member attached to the valve seat (claims 20, 31, and 38), applicants argue that "attach" should be given the broadest reasonable interpretation. However, this is misleading because the limitations not supported recite that the insert member is attached to specific structure (either the valving member or the valve seat). Attaching the insert member to either the valving member or the valve seat is clearly not disclosed by applicants. Applicants further argue that these features are not patentably distinct and therefore not material from the embodiment in applicants' disclosure. It should be noted that 35 USC 112 1st paragraph new matter and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record. Furthermore, since the specifics of the exact nature (how and where) of the attachment of the insert member across the flow path were amended into the independent claims of the '304 patent to overcome the prior art,

Art Unit: 3754

applicants arguments that those features fail to constitute patentably distinct features contradict the prosecution history of the patent upon which the present reissue is based (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance).

Re limitation iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42), there is no reasonable interpretation of “parabolic” that includes the pie-shaped wedge of applicants. Applicants argue that the ‘890 patent does not illustrate a true parabolic curve. The examiner disagrees. ‘890 clearly discloses a parabolic opening for the insert in both the specification and figures (see, for example, Figs. 4, 5, and 7 and column 5, line 26, column 6, lines 6 and 67, and column 7, lines 28 and 35, of the specification). Applicants disclose a pie-shaped wedge (see Figs. 3 or 5), the curved portion of the wedge is circular, not parabolic. Furthermore, applicants’ assertion that ‘890 does not disclose a true parabolic curve (i.e. the disclosure of ‘890 is not enabling for the claims of ‘890) is not germane to the issue being argued (i.e. does the disclosure of ‘304 support the claims of ‘890).

Re limitation v) the insert members made of plastic (claim 15), the material is not disclosed by applicants’ original disclosure. The argument that a claim limitation should be considered as disclosed if it not disclosed (but considered obvious) is without merit. Issues relating to 35 USC 112 1st paragraph (new matter) and 35 USC 251 (new matter) are not related to 35 USC 103 obviousness issues.

Re limitation vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14), applicants argue that “the inserts having a diameter corresponding to the diameter of the bore of the valving member” should be considered as

disclosed because applicants' insert is larger than the bore diameter and thus has "a diameter" arbitrarily chosen that would correspond to the bore diameter. This claim limitation can not reasonably be read that broadly because it is presented in dependent claim 13, which must further limit independent claim 10. The independent claim recites the insert and the insert must inherently correspond or be larger than the bore diameter. To further limit claim 10, claim 13 must be read as a distinct diameter on the insert rather than an arbitrarily chosen diameter.

Re limitation vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11), this feature is not disclosed. Applicants further argue that these features are not patentably distinct and therefore not material from the embodiment in applicants' disclosure. It should be noted that 35 USC 112 1st paragraph new matter issues and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record. Furthermore, since the specifics of the exact nature (how and where) of the attachment of the insert member across the flow path were amended into the independent claims of the '304 patent to overcome the prior art, applicants' arguments that those features fail to constitute patentably distinct features contradict the prosecution history of the patent upon which the present reissue is based (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance).

Re limitation viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40), this limitation is not disclosed. Applicants further argue that this feature is not patentably distinct and therefore not material from the embodiment in applicants' disclosure. It should be noted that 35 USC 112 1st paragraph new

matter issues and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record.

Re limitation ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45), applicants do not appear to argue this limitation. The insert of Marandi is attached across a passage through the valve member. The insert of Carlson et al. is attached outside the valve member across a passage going through the valve housing, not through the valve member.

Applicants' contention that none of the limitations identified by the examiner is material to patentability is not correct (applicants' further assertion that this is apparent from the final rejection of all copied claims over prior art is not understood because the claims have not been rejected over prior art). In fact, four of these limitations are directly related to the manner and location of connection between the insert member and either the valving member or the valve seat. Since the specifics of the exact nature (how and where) of the attachment of the insert member across the flow path were amended into the independent claims of the '304 patent to overcome the prior art, applicants' arguments that those features fail to constitute patentably distinct features contradict the prosecution history of the patent upon which the present reissue is based (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance). More importantly, 35 USC 112 1st paragraph new matter issues and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record.

It is clear that none of the above nine limitations are supported by the originally filed 09/084,698. Applicants assert that they are permitted to copy claims which contain limitations not found in the original disclosure. Applicants cite 37 CFR 1.606 and MPEP 2305 to support this assertion. The examiner disagrees. There is nothing in 37 CFR 1.606 or MPEP 2305 (or anywhere else) to support applicants' assertion. Furthermore, 37 CFR 1.606 has been deleted from the regulations.

Applicants then argue that they do not want to present claims without the new-matter limitations, but they expect the examiner to do so. It is not understood why applicants feel that they can not present such claims during prosecution. Furthermore, if all nine new-matter limitations were deleted from the claims, the breadth of the remaining claims would require prior art rejections.

Applicants argue that the recapture rejection should not have been made because applicants have chosen to copy the claims of another patent into a reissue application. However, applicants had pending applications (a divisional application and a continuation-in-part application) that could have served as the applications seeking to provoke the interference. The divisional had the same disclosure as the present reissue application and the CIP contained support for some of the limitations currently being rejected as new matter (although the time period to swear back would be much greater). However, applicants let both the divisional application and CIP application go abandoned in favor of choosing this reissue application to serve as the application that they seek to provoke an interference with. It would appear that this was a deliberate decision by applicants with no other purpose but to challenge the doctrine of

recapture. The rest of the argument regarding the recapture rejection was addressed in the previous examiner's answer and is repeated below:

Appellants argue that the application of recapture should not be rigid (i.e. automatically applied) and requires analysis of the particular factual situations. The examiner agrees with appellants' statement. That is why the particular factual situation has been analyzed by the examiner. It appears that appellants purport a rigid application of the doctrine of recapture (see page 10, second full paragraph). Appellants state "[i]n *Ball* the CAFC permitted a reissue applicant to proceed with claims which were narrower in some respects and broader in other respects than were the claims in the issued patent. Clearly, Appellants' claims 18, 21, and 23 are claims which the *Ball* Court would not have rejected based on recapture." Appellants advocate a rigid application of the recapture doctrine to permit claims which are narrower in some aspects and broader in other respects without an analysis of the particular factual situations regarding what subject matter was surrendered during prosecution of the patent upon which the present reissue is based and what limitations of the reissue claims are broader or narrower. Such a rigid application of the recapture doctrine would not be proper. The application of the recapture rule requires analysis of the particular factual situations regarding what subject matter was surrendered during prosecution of the parent application and what limitations of the reissue claims are broader or narrower. Application of the recapture rule is a multistep process. *Pannu v. Storz Instruments Inc.*, 59 USPQ2d 1597 (CAFC 2001)

The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. In the present situation, reissue claims 18, 21, and 23 are broader than the patent claims in the aspect of how and where the insert members (disks) are attached. Reissue

Art Unit: 3754

claims 18, 21, and 23 broadly recite that the insert members (disks) are merely “attachable across said fluid passage”. This is much broader than the particular attachment structure in independent claims 1, 4, and 6 of US Patent Number 6,039,304 which require the limitations “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”.

The second step is to determine whether the broader aspects of the reissued claims relates to the surrendered subject matter. This is clearly the case because the limitations “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings” were added to the independent claims in order to overcome the art rejections.

The third step is to determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. However, the only respects of the reissue claims that are narrower do not relate to the manner and location of the attachment. Therefore, the reissued claims were not narrowed in other respects to avoid the recapture rule.

The examiner has not applied a rigid doctrine. The examiner has done the requisite analysis of the particular factual situation. Reissued claims that are broader than the original patent’s claims in a manner directly pertinent to the subject matter surrendered during the prosecution are impermissible. See, for example, *In re Clement* (CAFC) 45 USPQ2d 1161:

“deliberate withdrawal or amendment does not involve inadvertence or mistake contemplated by Section 251, and recapture rule therefore prevents patentee from regaining,

through reissue, subject matter surrendered in effort to obtain allowance of original claims; under this rule, reissue claims that are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution are impermissible.”

Appellants offer no arguments about the particular factual situations regarding what subject matter was surrendered during prosecution of the patent upon which the present reissue is based and what limitations of the reissue claims are broader or narrower. Accordingly, argument B is without merit.

The present application has been remanded to the examiner for a determination of whether the recapture rejection remains appropriate in view of *Ex Parte Eggert*. The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal. The claims on appeal omit the surrender-generating limitations (i.e., the limitations added in the original prosecution to define over the prior art to secure allowance of the patent). This is because the limitations of the **patent** claims 1, 4, and 6 (i.e. “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”) that were added from claims 4, 17, and 27 of the original application, are essentially absent from the **reissue** claims 18, 21, and 23. Therefore, the claims impermissibly recapture what was previously surrendered.

The **reissue** claim 18, and its dependent claims 21 and 23, fail to recite the surrender-generating limitations (i.e. “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk

is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”), but instead recite that the disk, called “a *plurality* of disk-shaped inserts” in claim 18, is “attachable across the fluid passage.”

1) The recitation of the inserts or disks being “attachable across the fluid passage” is a functional limitation that is inherently present.

2) The new recitation of a “*plurality* of disk-shaped inserts” in reissue claim 18 in place of the disk in the patent claims is a narrowing limitation (as compared with the patent claims). It is supported in the patent’s specification at column 4, lines 13-14, but it is not shown in the drawings. This new narrowing feature of having a disk insert at both the inlet and outlet ports pertains to a feature for altering the fluid flow; this new feature is not related to the surrender-generating limitations (whose omission results in surrender), which both pertain to structure for retaining the disk in position.

Accordingly, reissue claims 18, 21, and 23 are broader than the original patent claims 1, 4, and 6 by not including the surrender-generating limitations. This broadening of the claims is barred by the recapture rule even though there is narrowing of the claims (e.g., a “plurality of disk-shaped inserts”) **not related** to the surrender-generating limitations.

The surrender-generating limitations (i.e. “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”) in claims 1, 4, and 6 of the original patent are germane to what was surrendered in response to a prior art rejection, as these claims were indicated as allowable when the base claim from which claims 4, 17, and 27 of the original

application depended (i.e. claims 1, 5, and 22) was rejected under prior art. Therefore, the limitations “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings” of claims 4, 17, and 27 were necessary in order to secure a patent. Similar to the facts in *Pannu v. Storz Instruments Inc.*, appellant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in an area not related to the surrender. The decision in *Pannu* is on point as to the issues on appeal, because it provides an actual fact situation in which this scenario was held to be recapture. It is noted that the Appeal Brief states on pages 9-10 that reissue claims 18, 21, and 23 “... are narrower in some aspects and broader in other respects than were in Appellant’s initial claims.” Appellant, however, fails to specifically point out what are the narrowing aspects. In this instance, there is no apparent replacement narrowing limitation that relates to the surrender-generating limitations, which pertain to how the disk is secured in position.

Because reissue claims 18, 21, and 23 omit the surrender-generating limitations and fail to include a replacement limitation in the area of the surrender, *Pannu* is on point while *Eggert* is not, and claims 18, 21, and 23 impermissibly recapture what was previously surrendered.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Keasel
Primary Examiner
Art Unit 3754